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**DEC 2 2 2003**

**OFFICE OF PETITIONS**

In re Application of:

Myers, et al.

Filed: 20 September, 2000

Application No. 09/666,369

Docket No.: 13028

: ON PETITION  
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This is a decision on the petition filed on 1 December, 2003 (and submitted as "Pursuant to 37 C.F.R. §1.8") and properly considered as a request to withdraw the holding of abandonment properly considered under 37 C.F.R. §1.181.

The petition is **GRANTED**.

**BACKGROUND**

The record indicates that:

- it appeared that Petitioner failed to reply timely and properly to the final Office action mailed on 10 September, 2002, with response due, absent an extension of time, on or before 10 December, 2003;
- the application was deemed abandoned after midnight 10 December, 2002;
- Notice of Abandonment was mailed on 23 September, 2003;
- accompanying the instant petition over the signature of Mark J. Cohen (Reg. No. 32,211) are *inter alia*: copies of the date-stamped (13 February, 2003) receipt card evidencing that Petitioner's Notice of Appeal (over a 10 February, 2003, certificate of mailing) and fee with a request and fee for a two- (2-) month extension of time was received in the Office;

- the file contains the referenced documents, copies of which Petitioner included with the petition as the reply to the final Office action, and Office records indicate that the fees were charged on 13 February, 2003.

It further is noted that, in lieu of filing an Appeal Brief, on August 13, 2003, Petitioner filed a Request for Continued Examination with fee and submission and a request and fee for a four-(4-) month extension of time.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>7</sup>

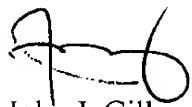
Petitioner contends and evidences timely reply.

CONCLUSION

Accordingly, Petitioner satisfied the burdens set forth in Delgar v. Schulyer, and the petition under 37 C.F.R. §1.181 hereby is **granted** and the 23 September, 2003, Notice of Abandonment is **vacated** and fees in connection with this petition are waived.

The instant application is forwarded to Technology Center 1700 for further processing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).